

REMARK**Response to Claim Objections**

Claims 1 and 40 have been amended to obviate the Examiner's formality objections.

Response to Claim Rejections Under 35 U.S.C. §112

Claims 1-4, 18-20 and 40 were rejected by the Examiner under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner rejected these claims for inconsistent claim terminology. The above amendments should render the claim language consistent and avoid this rejection.

Response to Claim Rejections Under 35 U.S.C. §102

Claims 1-4, 18, 19, 27,31 and 40 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by Mollenaure (U.S. Pat. No. 5,593,418). In response, applicants have amended claim 1 to require a tissue penetrating distal tip which forms the passageway and a tissue cutting member on the distal shaft section which is configured to separate a tissue mass which has a larger transverse dimension than the passageway through tissue to the site of the tissue mass separation. Mollenaure does not address the issue of separating a tissue mass with a transverse dimension larger than the passageway formed by a tissue penetrating distal tip. Moreover, Mollenaure fails to teach a biopsy device having a tissue cutting member, a tissue securing member and a tissue expander to facilitate removal of a tissue mass separated by the tissue cutting member and secured to the shaft by the tissue securing member. Applicants submit that the rejections based upon this reference has been overcome by the above

amendments to the rejected claims.

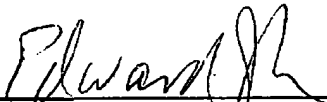
Response to Indication of Allowable Subject Matter

Applicants note with appreciation the Examiner's indication that claim 20 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. §112, second paragraph, set forth in the Office Action mailed on January 14, 2004 and to include all of the limitations of the base claim and any intervening claims. Applicants' amendments to claim 1 are believed to place claim 1 in condition for allowance, so no further amendments should be necessary for the allowance of claim 20.

Conclusions

Applicants believe that the pending claims define patentable subject matter and respectfully request that the pending claims, including those claims previously withdrawn, be further examined pursuant to applicants request for continued examination. An early allowance is earnestly solicited.

Respectfully submitted,

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